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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,123	06/26/2003	Teruaki Shinohara	045237-0121	3651
22428	7590	12/21/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			ROBINSON, MARK A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/606,123	Applicant(s) SHINOHARA, TERUAKI	
	Examiner Mark A. Robinson	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 11 is objected to because of the following informalities: it appears that "in" should be deleted in the second line. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This claim recites first and second mounting units which enable rotation in up-down and left-right directions. However, it appears that the only support for this limitation is found on page 15 of the specification which recites "mounting units of two directions as shown in Figs.

Art Unit: 2872

12,14, and 15." It is not clear what elements in these figures constitute the first and second mounting units and how they are capable of rotation. Further, this rotation is not shown by the figures or explained in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3,5,6,8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Iizuka (US 5610772).

Iizuka shows a mirror apparatus including housing(20), base(30), unit bracket(22), and mirror unit(12), wherein the housing, base and unit bracket are separately formed, the housing has two openings, the base has a base portion, first mounting portion(30) for attachment to a vehicle and second mounting portion(33) on another side for mounting the unit bracket, the unit bracket has first mounting portion (the "left" side as seen in fig. 3) for mounting the housing and mirror unit and a second mounting portion (the "right" side as seen in fig.

3) protruding from the second opening in the housing and mounted to the second portion of the base and forming, along with the second mounting portion of the base, a narrow neck (see fig. 1).

Regarding claim 2, note that mounting axes of the base portions are near each other.

Regarding claim 3, Iizuka's mounting arrangement is shown to be "suspended."

Regarding claim 5, the interface and cooperation between the mounting portions of Iizuka are considered to constitute a "backlash prevention unit" in a similar manner as the interface between these portions of the instant invention.

Regarding claim 6, Iizuka teaches rotation in two directions in col. 2 lines 61-65.

Regarding claim 8, Iizuka teaches cooperating flat surfaces in the paragraph bridging columns 2-3.

Regarding claim 10, Iizuka shows a power unit(24) on the first mounting portion of the unit bracket.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2872

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7,9,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iizuka (US 5610772).

Regarding claim 7, Iizuka teaches rotation in the left-right directions, but does not teach rotation in the up-down direction. However, mirror rotation arrangements for the up-down direction are well known in the art. It would have been obvious to the ordinarily skilled artisan at the time of invention to include such a rotation arrangement in Iizuka's device because of the increased adjustability this would provide.

Regarding claim 9, Iizuka teaches a through hole for a harness (see fig. 3), but does not teach a drain hole for draining water. However, drain holes in mirror devices are well known. It would have been obvious to the ordinarily skilled artisan at the time of invention to include a drain hole in Iizuka's mirror device to eliminate unwanted moisture from the interior of the device.

Iizuka meets the limitations of claims 11 and 12 as discussed above, but does not teach portions painted with

Art Unit: 2872

different colors. However, it is very common to use such a painting scheme on a vehicle mirror device. It would have been obvious to the ordinarily skilled artisan at the time of invention to paint the portions of the housing near the opening a different color than that of the base and unit bracket to improve the appearance of the device.

Allowable Subject Matter

8. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or suggest the sandwiched plate portion as set forth in the arrangement and combination of this claim.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McPherson and Hoek show mirror devices with separately formed base, bracket, and housing.

Art Unit: 2872

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

11/30/04


MARK A. ROBINSON
PRIMARY EXAMINER